

### **Remarks**

Claims 1-6, 8 and 9 are pending in this application. The Examiner rejected claims 1-6, 8 and 9 under 35 U.S.C. § 101 as directed to non-statutory subject matter. The Examiner rejected claim 8 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner rejected claims 1-6, 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,679,940 to Templeton *et al.* (Templeton). Applicants respectfully disagree with the Examiner's rejections and request reconsideration in view of the following arguments.

#### **The 35 U.S.C. § 101 Rejections**

Patentable subject matter is defined in M.P.E.P. § 706.03(a) as follows:

The subject matter of the invention or discovery must come within the boundaries set forth by 35 U.S.C. 101, which permits patents to be granted only for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof."

The term "process" as defined in 35 U.S.C. 100, means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

This section provides three examples of non-statutory subject matter: printed matter, naturally occurring articles and scientific principles.

Independent claim 1 provides a method of approving a money limit of check cashing. Independent claims 8 and 9 provide methods of check cashing. These claims are "process" claims as defined by 35 U.S.C. § 100. Further, these claims are not directed to printed matter, naturally occurring articles or scientific principles.

The Examiner asserts the pending claims are not within a technological art. Since when is processing checks not a technological art? The Examiner also asserts the pending claims fail the following test:

In the present case, the claim language does not preclude everything from being done in ones head. The classifying, receiving, determining, scores and subscores, etc. reiterated in the claims do not preclude each from being done in ones mind alone or in combination with pen and pencil.

From where did the Examiner get this test? It does not appear in the M.P.E.P., relevant statutes and codes, or in any recent court decision. The Examiner is not free to establish his own law as to what he believes should be patentable. Claims 1-6, 8 and 9 meet all recognized requirements for patentable subject matter

**The 35 U.S.C. § 112 Rejection**

The Examiner rejected claim 8 under 35 U.S.C. § 112, second paragraph, as being indefinite. In the final Office Action, the Examiner did not state what he believed was the cause of the indefiniteness in claim 8. Rather, the Examiner referred to an earlier Office Action. The undersigned believes the following to be what was referenced by the Examiner:

From line 10, "the time period" lacks antecedent basis (is it the "one time period" from line 2 or "each of the at least one time period" from lines 5 or 8). As is, it is not clear what is being referenced.

Claim 8 is reproduced, with line numbers for reference and with the words indicated by the Examiner as problematic highlighted, as follows:

1                    8.      A method of check cashing comprising:  
2                    establishing a cash limit for a check writer for at least one time period;  
3                    receiving a request to cash a check written for a specified amount and  
4      written by the check writer;  
5                    for each of the at least one time period, determining a total amount of  
6      cash from check writer checks cashed during an immediately preceding time equal  
7      to the time period; and  
8                    approving the request if, for each of the at least one time period, the  
9      total amount of cash from check writer checks cashed plus the specified amount is  
10      less than the cash limit for *the time period*.

Line 2 provides for establishing a cash limit for at least one time period. The element beginning on line 5 provides that, for each of the at least one time period, a determination of a total amount is made. The element beginning on line 8 provides for approval if, for each of

the at least one time period, the total amount plus a specified amount is less than a cash limit *for the time period*. Thus, the clause beginning on line 8 provides for using the total amount and cash limit for each time period to calculate an approval for that period. The check cashing request is approved only if the approval condition for each period is met.

### **The 35 U.S.C. § 103 Rejections**

The Examiner rejected claims 1-6, 8 and 9 as being obvious in view of Templeton. According to M.P.E.P. § 2142, three criteria must be met for the Examiner to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in Templeton or in knowledge generally available to one of ordinary skill in the art, to modify Templeton. Second, there must be a reasonable expectation that this modification will succeed. Finally, Templeton must teach or suggest all claim limitations.

Claim 1 provides, *inter alia*, for determining a money limit over a time period during which a check writer may cash checks up to the money limit based on a category in which the check writer is classified. Nowhere in the reasons provided to support the rejection does the Examiner point to any teaching or suggestion of such a money limit. In fact, the Examiner does not mention determining a limit of any kind, based on anything, anywhere in the final Office Action. It is axiomatic that the Examiner cannot establish a *prima facie* case without at least mentioning each and every limitation of the claim.

Claims 2-6 depend from claim 1 and are also patentable over the Examiner's rejections.

Claim 8 provides a method of check cashing. A cash limit is established for a check writer for at least one time period. A request to cash a check written for a specified amount and written by the check writer is received. For each of the at least one time period, a total amount of cash from check writer checks cashed during an immediately preceding time equal to the time period is determined. The request is approved if, for each of the at least one time period, the total amount of cash from check writer checks cashed plus the specified amount is less than the cash limit for the time period.

Claim 9 provides a method of check cashing. For each time period in a plurality of time periods, a cash limit for a check writer is established. A request to cash a check

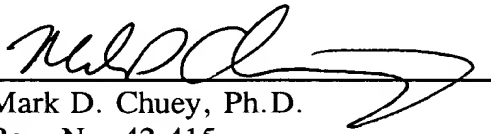
written for a specified amount and written by the check writer is received. A total amount of cash from check writer checks cashed during an immediately preceding time equal to the time period is determined. The request is approved if the total amount of cash from check writer checks cashed plus the specified amount is less than the cash limit.

The Examiner appears to have provided no support for rejecting either claim 8 or claim 9 as obvious over Templeton, as there is no mention of any limitations of these claims in the Examiners basis for rejections. In particular, there is no mention of a cash limit or of calculating a total amount of cash for a preceding time period. Once again, it is axiomatic that the Examiner cannot establish a *prima facie* case without at least mentioning each and every limitation of the claim.

Claims 1-6, 8 and 9, as pending in this application, meet all substantive requirements for patentability. Applicants therefore request that this case be passed to issuance. No fee is believed due by filing this paper. However, any fee due may be withdrawn from Deposit Account No. 02-3978 as specified in the Application Transmittal.

Respectfully submitted,

**CASSANDRA J. MOLLETT et al.**

By   
Mark D. Chuey, Ph.D.  
Reg. No. 42,415  
Agent for Applicant

Date: July 25, 2003

**BROOKS & KUSHMAN P.C.**  
1000 Town Center, 22nd Floor  
Southfield, MI 48075  
Phone: 248-358-4400  
Fax: 248-358-3351